

REMARKS

The present application was filed on June 29, 2001 with claims 1-24. In the outstanding Office Action dated April 29, 2005, the Examiner has: (i) rejected claims 1-3, 5, 8-10, 12, 15-20 and 22 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,772,413 to Kuznetsov et al. (hereinafter "Kuznetsov"); and (ii) rejected claims 4, 6, 7, 11, 13, 14, 21, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over Kuznetsov, in view of U.S. Patent Application Publication No. 2002/0174034 to Au et al. (hereinafter "Au").

In this response, claims 1, 8, 15, 17 and 18 have been canceled without prejudice, and claims 2-6, 9-13, 16 and 19-23 have been amended. Specifically, claims 4, 6, 11, 13, 21 and 23 have been recast into independent form, including all of the limitations of their respective base claims and any intervening claims. Claims 2, 3, 5, 9, 10, 12, 16, 19, 20 and 22 have been amended merely to provide proper dependency, as necessitated by the cancellation of claims 1, 8, 15 and 18. Applicants traverse the §103 rejection of the claims for at least the reasons set forth below. Applicants respectfully request reconsideration of the present application in view of the above amendments and the following remarks.

Claims 1-3, 5, 8-10, 12, 15-20 and 22 stand rejected under 35 U.S.C. §102(e) as being anticipated by Kuznetsov. With regard to independent claims 1, 8, 15 and 18, which are of similar scope, the Examiner contends that Kuznetsov discloses each of the limitations set forth in the subject claims. Claims 1, 8, 15 and 18 have been canceled, and therefore the §102(e) rejection of these claims is rendered moot. Additionally, with regard to claims 2, 3, 5, 9, 10, 12, 16, 17, 19, 20 and 22, Applicants submit that claims 2, 3 and 5, which previously depended from claim 1, have been amended to depend from claim 4, claims 9, 10 and 12, which previously depended from claim 8, have been amended to depend from claim 11, claim 16, which previously depended from claim 15, has been amended to depend from claim 4, and claims 19, 20 and 22, which previously depended from claim 18, have been amended to depend from claim 21. Therefore, the rejection of claims 2, 3, 5, 9, 10, 12, 16, 17, 19, 20 and 22 under §102(e) is also rendered moot.

Accordingly, Applicants respectfully request withdrawal of the §102(e) rejection of claims 1-3, 5, 8-10, 12, 15-20 and 22.

Claims 4, 6, 7, 11, 13, 14, 21, 23 and 24 stand rejected under §103(a) as being unpatentable over Kuznetsov, in view of Au. The Examiner acknowledges that Kuznetsov fails to disclose “identifying a postback universal resource locator (URL) associated with a target business entity; and sending the translated message to the postback URL; and storing the postback URL associated with the target business entity” (Office Action; page 7, paragraph 4). However, the Examiner contends that Au discloses such features (Office Action; page 7, last paragraph). Applicants assert that Au also fails to teach or suggest generating a conversation identifier associated with the business conversation and inserting the conversation identifier into the translated message, as recited in claims 4, 11 and 21, and the Examiner has not pointed out with specificity where in the combination of Kuznetsov and Au such additional features are disclosed..

While Applicants disagree with the Examiner’s contention, without characterizing the Au reference, Applicants submit that Au is not believed to be available as prior art for the purpose of sustaining an obviousness rejection against the claimed invention. Specifically, Au, which was filed prior to but was published after the filing date of the present application, and the claimed invention were, at the time the invention was made, owned by the same entity or subject to an obligation of assignment to the same entity, namely, International Business Machines Corporation. In the present application, this assignment was recorded on August 29, 2001, at reel 012139, frame 0820.

As set forth in 35 U.S.C. §103(c), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

For at least the reasons set forth above, Applicants submit that claims 4, 6, 7, 11, 13, 14, 21, 23 and 24 are patentable over the prior art. Accordingly, favorable reconsideration and allowance of these claims are respectfully solicited.

With regard to claims 2, 3, 5 and 16, which, as amended, depend from claim 4, claims 9, 10 and 12, which, as amended, depend from claim 11, and claims 19, 20 and 22, which, as amended, depend from claim 21, Applicants submit that these claims are also patentable over the prior art of record by virtue of their dependency from their respective base claims, which are believed to be

Application Serial No. 09/460,921

patentable for at the least the reasons given above. Furthermore, one or more of these claims define additional patentable subject matter in their own right. Accordingly, favorable reconsideration and allowance of claims 2, 3, 5, 9, 10, 12, 16, 17, 19, 20 and 22 are respectfully requested.

In view of the foregoing, Applicants believe that pending claims 2-7, 9-14, 16 and 19-24 are in condition for allowance, and respectfully request withdrawal of the §102(e) and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wayne L. Ellenbogen", with a long, sweeping horizontal line extending to the right.

Date: July 28, 2005

Wayne L. Ellenbogen
Attorney for Applicant(s)
Reg. No. 43,602
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-7662